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MAILED

DEC 02 2010

In re Patent No. 7,159,214	:	OFFICE OF PETITIONS
Issue Date: 2 January, 2007	:	
Application Number: 09/916,460	:	
Filing Date: 26 July, 2001	:	ON PETITION
Attorney Docket No.: UTL 00103	:	

This is a decision on the petition filed on 8 July, 2010, improvidently pursuant to 37 C.F.R. §1.377 (which provides for the Office to accept and record a maintenance fee for the above-identified patent), but the petition instead seeks refund of fees improvidently paid as to another patent, and more properly considered pursuant to 37 C.F.R. §1.182 and with consideration to the caution in the guidance provided in the Commentary at MPEP §503 and §607.02 as to the provisions of 37 C.F.R. §1.26,.

***NOTE:** Petitioner has failed to make the substantive documentary showing and appears not to have satisfied the applicable Rules of Practice and the guidance in the Commentary in the Manual of Patent Examining Procedure.*

The petition pursuant to 37 C.F.R. §1.182 is **DISMISSED**; the petition pursuant to 37 C.F.R. §1.377 is **DISMISSED** as having been improvidently filed; the fees for these petitions have been charged as authorized to Deposit Account 50-3001.

A request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. §1.182."

This is **not** a final agency action within the meaning of 5 U.S.C. §704.

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If reconsideration of this decision is desired, a petition for reconsideration under 37 C.F.R. §1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. An extension of this time limit may be requested pursuant to 37 C.F.R. §1.136(a). The petition for reconsideration shall include an exhaustive attempt to provide the lacking item(s) noted below

This is **not** a final agency action within the meaning of 5 U.S.C. §704.

Petitioner has failed not only to satisfy the showing described above as to the requirements under the Rule, Petitioner mis-appreciates the Rule under which relief is properly sought.

It is noted that Petitioner did not include with the petition the required documentary showing, along with the required statement/declaration by person(s) having first-hand knowledge of the facts averred.

BACKGROUND

Petitioner alleged that her office sought to pay the maintenance fee on the instant patent (Patent No. 7,159,214), but paid instead the fee on Patent No. 7,154,214. Thereafter Petitioner sought refund from the Office of Finance, which referred Petitioner to the Office of Petitions.

Petitioner filed the instant petition, improvidently pursuant to 37 C.F.R. §1.377 (which provides for the Office to accept and record a maintenance fee for the above-identified patent), but, of course sought not to have fees accepted, as is the foundation of that Rule, but to obtain refund of fees improvidently paid as to another patent, and more properly considered pursuant to 37 C.F.R. §1.182 and with consideration to the caution in the guidance provided in the Commentary at MPEP §503 and §607.02 as to the provisions of 37 C.F.R. §1.26,.

ANALYSIS

The regulations at 37 C.F.R. §1.377 provide:

§ 1.377 Review of decision refusing to accept and record payment of a maintenance fee filed prior to expiration of patent.

(a) Any patentee who is dissatisfied with the refusal of the Patent and Trademark Office to accept and record a maintenance fee which was filed prior to the expiration of the patent may petition the Director to accept and record the maintenance fee.

(b) Any petition under this section must be filed within two months of the action complained of, or within such other time as may be set in the action complained of, and must be accompanied by the fee set forth in § 1.17(g). The petition may include a request that the petition fee be refunded if the refusal to accept and record the maintenance fee is determined to result from an error by the Patent and Trademark Office.

(c) Any petition filed under this section must comply with the requirements of §1.181(b) and must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest.

[49 FR 34725, Aug. 31, 1984, added effective Nov. 1, 1984; para. (c) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (a) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; para. (b) revised, 69 FR 56481, Sept. 21, 2004, effective Nov. 22, 2004]

The guidance in the Commentary at MPEP §2580 provides in pertinent part:

2580 Review of Decision Refusing to Accept and Record Payment of a Maintenance Fee Filed Prior to Expiration of Patent [R-5]

37 C.F.R. §1.377 provides a mechanism for review of a decision refusing to accept and record payment of a maintenance fee filed prior to the expiration of a patent. 37 C.F.R. §1.377(a) permits a patentee who is dissatisfied with the refusal of the Office to accept and record a maintenance fee which was filed prior to the expiration of the patent to petition the Director to accept and record the maintenance fee. This petition may be used, for example, in situations where an error is present in the identifying data required by 37 C.F.R. §1.366(c) with the maintenance fee payment, i.e., either the patent number or the application number is incorrect. See MPEP §2515 and §2530. A petition under 37 C.F.R. §1.377 would not be appropriate where there is a complete failure to include at least one correct mandatory identifier as required by 37 C.F.R. §1.366(c) for the patent since no evidence would be present as to the patent on which the maintenance fee was intended to be paid. If the maintenance fee payment with an incorrect mandatory identifier was made near the end of the grace period, the patent might expire since the Office would not credit the fee to the patent. A petition under 37 C.F.R. §1.377 would not be appropriate where the patentee paid a maintenance fee on one patent when the patentee intended to pay the maintenance fee on a different patent but through error identified the wrong patent number and application number. Likewise, a petition under 37 C.F.R. §1.377 would not be

appropriate where the entire maintenance fee payment, including any necessary surcharge, was not filed prior to expiration of the patent.

Any petition filed under 37 C.F.R. §1.377 must be filed within 2 months of the action complained of, or within such other time as may be set in the action complained of. The petition must be accompanied by the proper petition fee >(37 C.F.R. §1.17(g))<. The petition may include a request that the petition fee be refunded if the refusal to accept and record the maintenance fee is determined to have resulted from an error by the Office.

Any petition filed under 37 C.F.R. §1.377 must comply with the requirements of 37 C.F.R. §1.181(b) and must be signed by an attorney or agent registered to practice before the Office, or by the patentee, the assignee, or other party in interest. A person or organization whose only responsibility insofar as the patent is concerned is the payment of a maintenance fee is not a party in interest for purposes 37 C.F.R. §1.377. If the petition is signed by a person not registered to practice before the Office, the petition must indicate whether the person signing the petition is the patentee, assignee, or other party in interest. An assignee must comply with the requirements of 37 C.F.R. §3.73(b) which is discussed in MPEP §324.

Thus, the vehicle pursuant to which Petitioner sought relief is not the one proper for the relief which Petitioner seeks.

At the time the instant matter was filed, Congress directed and 35 U.S.C. ' 41 provided that the "Director shall charge" the fees set forth.

The Congressional statutory statement of the timing and structure of fees is a mandate, not a suggestion.¹

Similarly the regulations at 37 C.F.R. ' 1.22 provide, *inter alia*:

' 1.22 Fees payable in advance.

(a) Patent fees and charges payable to the United States Patent and Trademark Office are required to be paid in advance; that is, at the time of requesting any action by the Office for which a fee or charge is payable

¹ AShall@ is the language of command. *Escoe v. Zerbst*, 295 U.S. 490, 55 S.Ct. 818, 79 L.Ed. 1566 (1935); *Boyden v. Commissioner of Patents*, 441 F. 2d 1041 (Ct. App. DC Cir. 1971).

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with the exception that under ' 1.53 applications for patent may be assigned a filing date without payment of the basic filing fee.

* * *

The discussion of the charge of fees is set forth in the commentary at MPEP ' 601.01(a) states:

* * *

For applications filed on or after July 1, 2005, which have been accorded a filing date under 37 CFR 1.53(b) or (d), if any of the basic filing fee, the search fee, or the examination fee are paid on a date later than the filing date of the application, the surcharge under 37 CFR 1.16(f) is required.

* * *

Petitioner's attentions also are directed to the caution in the guidance set forth in the Commentary at MPEP ' 503:

Applications which are entitled to a filing date and are filed, whether by regular mail*>, by< "Express Mail" under 37 CFR 1.10, by hand-delivery>, by the Office's Electronic Filing System (EFS),< or otherwise, will not be returned to applicant even if requested. See 37 CFR 1.59. Accordingly, applicants must be careful not to file applications which are not intended to be filed, e.g., duplicates of applications already filed. Note that 37 CFR 1.26(a) provides that a change of purpose after the payment of a fee, as when a party desires to withdraw the filing of a patent application for which the fee was paid, will not entitle the party to a refund of such fee. See MPEP § 607.02. (Emphasis supplied)

Similarly the regulations at 37 C.F.R. ' 1.26 provide:

§ 1.26 Refunds.

(a)The Director may refund any fee paid by mistake or in excess of that required. A change of purpose after the payment of a fee, such as when a party desires to withdraw a patent filing for which the fee was paid, including an application, an appeal, or a request for an oral hearing, will not entitle a party to a refund of such fee. The Office will not refund amounts of twenty-five dollars or less unless a refund is specifically requested, and will not notify the payor of such amounts. If a party paying a fee or requesting a refund does not provide the banking information necessary for making refunds by electronic funds transfer (31 U.S.C. 3332 and 31 CFR part 208), or instruct the Office that refunds are to be credited to a deposit account, the Director may require such information, or use the banking information on the payment instrument to make a refund. Any refund of a fee

paid by credit card will be by a credit to the credit card account to which the fee was charged.

(b) Any request for refund must be filed within two years from the date the fee was paid, except as otherwise provided in this paragraph or in § 1.28(a). If the Office charges a deposit account by an amount other than an amount specifically indicated in an authorization (§ 1.25(b)), any request for refund based upon such charge must be filed within two years from the date of the deposit account statement indicating such charge, and include a copy of that deposit account statement. The time periods set forth in this paragraph are not extendable.

(c) If the Director decides not to institute a reexamination proceeding, for *ex parte* reexaminations filed under § 1.510, a refund of \$1,690 will be made to the reexamination requester. For *inter partes* reexaminations filed under § 1.913, a refund of \$7,970 will be made to the reexamination requester. The reexamination requester should indicate the form in which any refund should be made (e.g., by check, electronic funds transfer, credit to a deposit account, etc.). Generally, reexamination refunds will be issued in the form that the original payment was provided.

Similarly the guidance in the Commentary at MPEP '607.02 provides in pertinent part:

When an applicant or patentee takes an action "by mistake" (e.g., files an application or maintains a patent in force "by mistake"), the submission of fees required to take that action (e.g., a filing fee submitted with such application or a maintenance fee submitted for such patent) is not a "fee paid by mistake" within the meaning of 35 U.S.C. 42(d).

Thus, when Petitioner paid the fee for another patent, and that fee was due at the time, Petitioner's designation was not a "fee paid by mistake within the meaning of 35 U.S.C. 42(d).

Petitioner, as one registered to practice before the office, is not unfamiliar with the statutory provisions, the regulations and the commentary cited above.

The availability of applications and application papers online to applicants/practitioners who diligently associate their Customer Number with the respective application(s) now provides an applicant/practitioner on-demand information as to events/transactions in an application.

Out of an abundance of caution, Petitioners always are reminded that those registered to practice and all others who make representations before the Office **must** inquire into the underlying facts

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of representations made to the Office and support averments with the appropriate documentation—since all owe to the Office the continuing duty to disclose.²

CONCLUSION

Petitioner has failed to the requirements herein.

Accordingly, the petition pursuant to 37 C.F.R §1.182 is **dismissed**; the petition pursuant to 37 C.F.R §1.377 is **dismissed** as improvident. As noted above, the petition fees have been charged as authorized.

Further correspondence with respect to this matter should be addressed as follows:

By Mail: Mail Stop PETITION
 Commissioner for Patents
 P. O. Box 1450
 Alexandria, VA 22313-1450

By hand: U. S. Patent and Trademark Office
 Customer Service Window, Mail Stop Petitions
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

By facsimile: (571) 273-8300
 Attn: Office of Petitions

² See supplement of 17 June, 1999. The Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office).

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While telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214, it is noted that all practice before the Office is in writing (see: 37 C.F.R. §1.2³) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).

/ John J. Gillon, Jr /
John J. Gillon, Jr.
Senior Attorney
Office of Petitions

³ The regulations at 37 C.F.R. §1.2 provide:

§1.2 Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.